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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Samuel H. Christie, IV  
Serial No. 09/102,016  
Filed: 06/22/1998  
For: **TREATMENTS IN A DISTRIBUTED COMMUNICATIONS SYSTEM**

Examiner: Boakye, Alexander  
Art Unit: 2666

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

The present APPEAL BRIEF is filed in triplicate pursuant to 37 C.F.R. § 1.192. Applicant also encloses a credit card form authorizing payment in the amount of \$340.00 as required by 37 C.F.R. § 1.17(c). If any additional fees are required in association with this appeal brief, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

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**APPEAL BRIEF**

**(1) REAL PARTY IN INTEREST**

The present application is owned by Nortel Networks Limited of 2351 Boulevard Alfred-Nobel, St. Laurent, Quebec Canada H4S 2A9, which is wholly owned by Nortel Networks Corporation, a Canadian corporation.

**(2) RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences to the best of Appellant's knowledge.

**(3) STATUS OF CLAIMS**

Claims 61-120 are pending and stand rejected with the rejection made final.

Claims 61-120 are pending and are the subject of the present appeal.

**(4) STATUS OF AMENDMENTS**

Appellant last amended the claims in the Response filed February 24, 2004. These amendments were entered, and the Patent Office generated the Final Office Action of May 6,

2004 in response thereto. Appellant did not amend the claims in the Response After Final filed July 6, 2004, although box 2 of the Advisory Action mailed August 27, 2004 is checked and the continuation sheets goes so far as to state that the “additions/deletions made to claims 61, 62, 63, 70, 71, 76, 77, 78, 85, 86, 91, 92, 97, 100, 101, 106, 107, 108, 112, 115, and 116 would raise new issues..[sic]” There were no amendments made, and as such, there were no new amendments that could raise new issues such that they should not be entered. To the best of Appellant’s knowledge, all amendments have been entered.

#### **(5) SUMMARY OF THE INVENTION**

The present invention is part of a family of inventions relating to communications between two packet based telephony devices. The particular invention at issue in the present application is described more fully beginning on page 16 of the specification as filed. In particular, the present invention is directed to providing better treatment options to parties involved in a call. Treatments include prerecorded music while the caller is on hold, a message concerning why the connection was not made, such as a disconnected number, or the like (page 1, lines 19-23). From the perspective of a calling party, the calling party tries to make a call through their communication device (step 500). The communication device, particularly the phone portion of the communication device, receives a packet based indication that the call was not completed (page 17, lines 22-25). The calling party’s communication device then receives a packet based indication of the treatment that the calling party should receive related to the attempted call (page 17, lines 25-30 and step 504). The functionality of the called party’s communication device is essentially the converse of the functionality of the calling party’s communication device. The called party’s communication device receives an indication that a call is being attempted, provides an indication that the call was not completed, and provides an indication of the treatment to be provided to the calling party. The indication that the call was not completed and the indication of the treatment to be received by the calling party are sent to the calling party’s communication device in the form of packet based messages. Likewise, the treatment is provided using packets (page 18, lines 13-15).

#### **(6) ISSUES**

a) Whether claims 61-64, 66, 68-71, 73-79, 81, 83-86, 88-94, 96, 98-101, 103-105, and 107-109 are unpatentable under 35 U.S.C. § 102(e) over White et al.

b) Whether claims 65, 67, 69, 72, 75, 80, 82, 84, 87, 95, 97, 99, 102, 106, 110, and 117 are unpatentable under 35 U.S.C. § 103(a) over White et al. in view of Creswell, et al.

c) Whether claims 106-109, 111-116, and 118-120 are unpatentable under 35 U.S.C. § 103(a) over White et al.

## **(7) GROUPING OF CLAIMS**

Claims 61, 66-70, 73-76, 81-85, 88-91, 96-100, and 103-105 are grouped together and stand or fall together.

Claims 62-64, 71, 77-79, and 86 are grouped together and stand or fall together.

Claims 92-94 and 101 are grouped together and stand or fall together.

Claims 65, 72, 80, 87, 95, 102, 110, and 117 are grouped together and stand or fall together.

Claims 106-109, 111-116, and 118-120 are grouped together and stand or fall together.

## **(8) ARGUMENT**

### **A. Introduction**

The Patent Office's Office Actions fail to show why the claims are anticipated or obvious over the references of record. Specifically, the Patent Office has not shown each and every claim element in White et al. as required in an anticipation analysis. Further, the Patent Office has not met its procedural burdens to modify or combine the references in the obviousness rejections. Even if the Patent Office has satisfied its procedural burdens to modify or combine the references, the Patent Office has not established *prima facie* obviousness since White et al. and Creswell et al. still do not teach or suggest receiving at the calling party's communication device a packet based message providing an indication of a treatment corresponding to the attempted communication session. Since the Patent Office has not established anticipation or obviousness, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the application.

### **B. Standards for Anticipation and Obviousness**

## 1. Anticipation

### a. The Statute

35 U.S.C. § 102 states *inter alia*:

A person shall be entitled to a patent unless -

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(e) the invention was described in

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(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a). . . .

### b. The Interpretation

The Federal Circuit's test for anticipation has been set forth numerous times. "It is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention . . . ." *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). This standard has been reinforced. "To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter." *PPG Indus., Inc. v. Guardian Indus. Corp.*, 75 F.3d 1558, 1566 (Fed. Cir. 1996) (citations omitted). "[A] finding of anticipation requires that the publication describe all of the elements of the claims, arranged as in the patented device." *C.R. Bard Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1349 (Fed. Cir. 1998) (emphasis added and citations omitted). As stated in the statute, anticipation relies on a reference. That is,

[n]ormally, only one reference should be used in making a rejection under 35 U.S.C. 102. However, a 35 U.S.C. 102 rejection over multiple references has been held to be proper when the extra references are cited to:

- (A) Prove the primary reference contains an "enabled disclosure;"
- (B) Explain the meaning of a term used in the primary reference; or
- (C) Show that a characteristic not disclosed in the reference is inherent.

MPEP § 2131.01. These three exceptions to the one reference rule are not present in the current application.

In determining whether a claim element is present in the reference, the Patent Office is entitled to give the claim element a broad reasonable interpretation, but the term "**reasonable**" is still in the standard. Further, the broadest reasonable interpretation must be consistent with the

interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353 (Fed. Cir. 1999); MPEP § 2111.

If a claim element is not present in the reference, or the reference is not arranged as claimed, then the reference is not an anticipatory reference, and a rejection under 35 U.S.C. § 102 is improper.

## **2. Obviousness**

### **a. The Statute**

Section 103(a) of the Patent Act provides the statutory basis for an obviousness rejection and reads as follows:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

### **b. The Interpretation**

There are essentially two basic ways that an obviousness rejection can be formulated, and there is a third way to form an obviousness rejection that relies on a combination of the two basic ways. The first basic way a claim can be rejected under 35 U.S.C. § 103 is through a modified reference. That is, while the reference does not disclose every element of the claim as required under 35 U.S.C. § 102, there is a suggestion to modify the reference to include the missing claim element such that the modified reference teaches each of the claim elements. The second basic way a claim can be rejected under 35 U.S.C. § 103 is through a combination of references. That is, there is a suggestion to combine two or more references to show all the claim elements. The third way a claim can be rejected under 35 U.S.C. § 103 is through a combination of references, one of which is modified to show a missing claim element.

It is well recognized that almost every invention is a combination of elements from the prior art. *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991). One of the things that makes an invention patentable is that it would not have been obvious to one of ordinary skill in the art to modify or combine the references in the manner claimed.

The Federal Circuit has prohibited the Patent Office from using hindsight reconstruction when making an obviousness rejection. *In re Gorman*, 933 F.2d 892 (Fed. Cir. 1991). To help

combat the possibility of such hindsight reconstruction, The Federal Circuit has established several rules with which the Patent Office must comply when making an obviousness rejection. Initially, the references may not be gathered with the claimed invention in mind. *Pentec, Inc. v. Allen*, 776 F.2d 309, 313 (Fed. Cir. 1985). Furthermore, the Federal Circuit has cautioned that “one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988). To reconstruct the invention by the selective extraction from the prior art constitutes impermissible hindsight. *In re Gorman*. A reference must be considered for all it teaches. *In re Fritch*, 972 F.2d 1260, 1264 (Fed. Cir. 1992). The Federal Circuit has indicated that the Patent Office cannot remove elements from a reference, and cannot take single elements out of the reference. *Id.* at 1266.

As yet another “defense against the subtle but powerful attraction of a hindsight-based obviousness analysis”, the Federal Circuit has stated that when the Patent Office proposes a combination of references, the Patent Office must do two things. First, the Patent Office must articulate a motivation to combine the references, and second, the Patent Office must provide actual evidence in support of the articulated motivation. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999); *see also In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002). The Federal Circuit acknowledged that there are myriad sources of support, including the references, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. The “range of sources available, **does not diminish the requirement for actual evidence.**” *In re Dembiczak* at 999 (emphasis added).

The year after *Dembiczak*, the Federal Circuit followed *Dembiczak* by applying the actual evidence requirement to modifications of single references. Specifically, to modify a single reference, the Patent Office must articulate a motivation to modify the reference, and then further support such motivation to modify with actual evidence. Specifically, the Federal Circuit stated “[e]ven when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.” *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000).

This is not a new standard, because as early as 1992, the Federal Circuit had applied a similar rule to a modified combination. The Federal Circuit held that even after combination, the combination may not be modified absent an additional showing of a suggestion of the

desirability of the modification. *In re Fritch* at 1266 (citing *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984)).

After the modification, the combination, or the modified combination has been made, for a *prima facie* case of obviousness, the Patent Office's creation must still teach or suggest all of the claim elements. *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974); MPEP § 2143.03. If a claim element is lacking, then the Patent Office has not established *prima facie* obviousness. "If the PTO fails to meet this burden, then the Appellant is entitled to the patent." *In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002).

### **C. White Does Not Anticipate Claims 61-64, 66, 68-71, 73-79, 81, 83-86, 88-94, 96, 98-101, 103-105, and 107-109**

#### **1. White Does Not Show a Claim Element**

On the following issue, all the claims stand or fall together. However, many of the other claims have independent reasons why such other claims are independently patentable. After addressing this primary issue that affects all the claims, Appellant will address each of the other issues in turn.

Each of the independent claims recites some permutation of an element that appears prominently in the first independent claim 61. Specifically, claim 61 recites "receiving at the calling party's communication device a packet based message providing an indication of a treatment corresponding to the attempted communication session. . . ." The Patent Office opines that White teaches "receiving means (Fig. 12) for receiving at the calling party's communications device (W, Fig. 12) a packet based message (106, Fig. 12) providing an indication of a treatment (column 21, line 64-column 22, lines 1-7) corresponding to the attempted communications session. . . ."<sup>1</sup> This construction of White does not show the recited claim element. The Patent Office's construction of White indicates that element W is the calling party's communication device. To satisfy the recited claim element, element W has to receive "a packet based message providing an indication of a treatment corresponding to the attempted communication session. . . ." As the cited passage of White discloses, element W receives no such packet based message to provide an indication of a treatment corresponding to the attempted communication session. Specifically, White recites:

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<sup>1</sup> Office Action of May 6, 2004, page 3, lines 10-13.

At S3 the attempt to establish a voice connection between the two telephone stations is terminated and the caller is connected to the voice messaging system VMS 125 associated with the originating end office EO 129. The voice processing unit associated with the voice messaging system VMS 125 informs the caller that the line is busy or that there is no answer. The prompt also inquires as to whether or not the caller would like to leave a message and have it delivered. It also indicates that if the caller chooses to leave a message for delivery the charge will be, for example, seventy-five cents.<sup>2</sup>

Thus, the caller at telephone station W is connected to the voice messaging system VMS 125 through the end office EO 129. VMS 125 informs the caller that the line is busy, or that there is no answer, and prompts the caller to leave a message. The communication between VMS 125, EO 129, and telephone station W does not pass through Internet 106. Since the communication from VMS 125 to the telephone station W does not pass through the Internet 106, there is no indication that telephone station W receives a packet based message providing an indication of a treatment corresponding to the attempted communication session, as recited in the claims. Rather, White teaches that the VMS 125 sends a telephony protocol message to the telephone station W through the EO 129. White's teaching is not the same as the recited claim element, especially in the rigorous crucible of an anticipation analysis.

In response to Appellant's arguments on this point, the Patent Office stated "the examiner maintains that block 106, Fig. 12 which is an internet is a packet based network."<sup>3</sup> This statement may be true, but this statement does not address the fact that the communication between VMS 125 and telephone station W does not pass through Internet 106. The Patent Office further opines that White, column 22, lines 15-33, teaches that the VMS provides a packet message to the calling party's device.<sup>4</sup> White states:

Subsequent to storage of the message as digital data, the message is transferred via the Internet from the public mailbox in voice messaging system VMS 125 to a temporarily mating or corresponding public mailbox in voice messaging system VMS 127. This is shown at S6. Such transfer is effected through the Internet in the manner previously described. Following deposit or storage of the message in the destination voice messaging system VMS 127, that voice mail system initiates attempts to reach the called party or addressee at telephone station Z to announce to that party that a message has been deposited. This is shown at S7. The same announcement may include the instruction that the message may be heard by depression of a stated DTMF key. The actuation of the key may initiate the

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<sup>2</sup> White, column 21, line 64-column 22, line 7.

<sup>3</sup> Office Action of May 6, 2004, page 8, lines 18-19.

<sup>4</sup> Office Action of May 6, 2004, page 9, lines 3-4.

creation of a record constituting a receipt for the originating party. The digitally stored voice message is then delivered from the voice messaging system VMS 127 to the caller at station Z as an audio voice message in the conventional fashion. This is shown at S8.<sup>5</sup>

This passage indicates that VMS 125 transfers, admittedly via Internet 106, the message to VMS 127. However, the Patent Office has identified telephone station W as the calling party's communication device, not VMS 127. Thus, the communication between VMS 125 and VMS 127 is irrelevant to a determination as to whether the communication between the calling party's communication device (telephone station W) and VMS 125 is packet based. The Patent Office's reliance on the above passage of White is misplaced, because White does not show "receiving at the calling party's communication device a packet based message providing an indication of a treatment corresponding to the attempted communication session", as recited in the claim. White does not show the recited claim element at column 22, lines 15-33 because that passage does not discuss telephone station W (the element the Patent Office has identified to be the calling party's communication device of the claim) receiving anything, much less the packet based message recited in the claim.

Since White does not teach the recited claim element, White cannot anticipate claim 61. As argued before the Examiner, the other independent claims all recite a similar element, and on this issue, all the claims stand or fall together. Since White does not anticipate the claims, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow claims 61-120 on this basis.

## **2. White Is Not Arranged As Claimed With Respect to Claims 62-64, 71, 77-79, and 86**

In the rejection of claims 62-64, 71, 77-79, and 86, the Patent Office asserts that White teaches a cause value (as recited in the claims) at column 3, lines 36-49. The problem with this citation is that White, column 3, lines 17-57 occurs in the "Background Art" section of White, where White discusses U.S. Patent 5,384,831 to Creswell, not White's invention. Anticipation strictly requires that the elements of the reference are arranged as claimed. *C.R. Bard Inc. v. M3 Sys. Inc.* Since White does not interrelate White's system components to the system components of Creswell, Creswell's system components form no part of the White system, and elements within Creswell's system are not, and cannot be, arranged relative to the rest of White's system.

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<sup>5</sup> White, column 22, lines 15-33.

Since Creswell's system is not part of White's system, the elements cited by the Patent Office are not arranged within the reference as they are arranged within the claim. Since the elements of the reference are not arranged as claimed, White cannot, under the strict analysis of an anticipation rejection, anticipate claims 62-64, 71, 77-79, and 86. White's failure to be arranged as claimed constitutes an independent reason why claims 62-64, 71, 77-79, and 86 are not anticipated by White. To this extent, on this issue, claims 62-64, 71, 77-79, and 86 stand or fall together, but independently of the other pending claims. Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow claims 62-64, 71, 77-79, and 86 on this basis.

Even if Creswell's system is part of the White system, and is properly arranged relative to White's components (points which Appellant does not concede), there is still no teaching within the cited passage of a cause value as recited in the claims. Specifically, White, in his discussion of the Creswell system, states in full:

A public switch telephone network 100 (FIG. 1) includes switching offices 110, 130 and 140 connected through central offices 10 and 20 with stations S1 through S6. Service adjunct 150 operates to process a call associated with one of the subscribers. Voice message service 200 receives voice messages from a calling party via adjunct 150 and network 100. The voice message is addressed to a party who has subscribed to the voice message service that stores messages. A subscriber can dial up service 200 via adjunct 150 and enter a PIN or password. The PIN unloads, from its internal memory, the voice message and transmits the message to the called party's station set via a network connection established between the subscriber set and service.<sup>6</sup>

The cited passage describes a voice messaging service. However, there is nothing in the passage that is reflective of receiving a cause value explaining why the attempted communication session was not completed at the calling party's communication device as set forth in the claims. To this extent, the passage does not teach the element for which it is cited, and White fails to disclose a claim element. The Patent Office responds to Appellant's arguments on this point by stating that "the cause value recited in the claims is inherent in whites [sic] VMS."<sup>7</sup> This statement has never been substantiated by the Patent Office, and the Patent Office has never addressed Appellant's argument that a cause value need not necessarily be part of a voice messaging

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<sup>6</sup> White, column 3, lines 36-49.

<sup>7</sup> Office Action of May 6, 2004, page 9, lines 7-8.

system signaling flow as required under MPEP § 2112 and thus, White does not inherently show a cause value.

Since White fails to disclose a claim element, this comprises an independent reason why claims 62-64, 71, 77-79, and 86 are not anticipated. Since claims 62-64, 71, 77-79, and 86 are not anticipated for this reason, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow claims 62-64, 71, 77-79, and 86 on this basis.

### **3. White Is Not Arranged As Claimed With Respect to Claims 92-94 and 101**

In the rejection of claims 92-94 and 101, the Patent Office asserts that White teaches the receiving a cause value as recited in the claims at column 4, lines 13-28. The problem with this citation is that White, column 4, lines 5-37 occurs in the “Background Art” section of White, where White discusses U.S. Patent 4,313,035 to Jordan et al. Anticipation strictly requires that the elements of the reference are arranged as claimed. *C.R. Bard Inc. v. M3 Sys. Inc.* Since White does not interrelate White’s system components to the system components of Jordan et al., Jordan et al.’s system components form no part of the White system, and elements within Jordan et al.’s system are not, and cannot be, arranged relative to the rest of White’s system. Since Jordan et al.’s system is not part of White’s system, the elements cited by the Patent Office are not arranged within the reference as they are arranged within the claim. Since the elements of the reference are not arranged as claimed, White cannot, under the strict analysis of an anticipation rejection, anticipate claims 92-94 and 101. White’s failure to be arranged as claimed constitutes an independent reason why claims 92-94 and 101 are not anticipated by White. To this extent, on this issue, claims 92-94 and 101 stand or fall together, but independently of the other pending claims. Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow claims 92-94 and 101 on this basis.

Even if Jordan et al.’s system is part of the White system, and is properly arranged relative to White’s components (points which Appellant does not concede), there is still no teaching within the cited passage of a cause value as recited in the claims. Specifically, White describes Jordan’s system, stating in full:

Each subscriber to the locator service has a unique person locator telephone number (PLN). To access the system to update data in the data base, the subscriber dials 0700 and his unique person locator telephone number. The telephone switching office routes the call to a traffic service position system (TSPS), which prompts the caller (e.g., provides an additional dial tone) and receives further digits from the subscriber. The subscriber inputs a three digit

access code, indicating the type of update call, and a four digit personal identification number. If calling from the remote station to which the subscriber wishes his calls routed, the local switching office forwards the line identification number of that station to the TSPS. The TSPS forwards the dialed information and the line identification to the data base for updating the particular subscriber's location record.<sup>8</sup>

The cited passage describes the caller inputting a person locator telephone number and the subsequent processing thereof. However, there is nothing in the passage that is reflective of receiving a cause value at the calling party's communication device as set forth in the claims. To this extent, the passage does not teach the element for which it is cited, and therefore White fails to disclose a claim element. Since White fails to disclose a claim element, this comprises an independent reason why claims 92-94 and 101 are not anticipated. Since claims 92-94 and 101 are not anticipated for this reason, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow claims 92-94 and 101 on this basis.

#### **4. Claims 107-109 Cannot Be Anticipated By White**

The Patent Office rejects claims 107-109 as being anticipated by White.<sup>9</sup> Claims 107-109 depend from claim 106, and, by virtue of this dependency, include all the elements of claim 106. As noted above, for an anticipation rejection to be proper, the reference must show each and every element of the claim. The Patent Office admits that White does not show all the elements of claim 106, and therefore, White cannot show all the elements of claims which depend therefrom. Specifically, the Patent Office states, "White does not explicitly disclose a computer readable medium containing instructions for controlling a computer system."<sup>10</sup> Since White does not show this claim element, White cannot show the claim element for dependent claims 107-109. To this extent, White cannot anticipate claims 107-109. Appellant has previously argued this point.<sup>11</sup> The Patent Office responded in the Office Action of May 6, 2004 with the statement that "the claimed computer readable medium reads on white's [sic] internet gateway router of Figure 3."<sup>12</sup> Appellant has pointed out the mutually contradictory nature of these statements, asked for clarification, and argued that this construction of the term "computer readable medium" is incorrect. No one of ordinary skill in the art would construe an internet

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<sup>8</sup> White, column 4, lines 13-28.

<sup>9</sup> Office Action of May 6, 2004, page 2, lines 15-17.

<sup>10</sup> Office Action of May 6, 2004, page 6, lines 5-6.

<sup>11</sup> Response filed February 24, 2004, page 12, lines 24-27.

<sup>12</sup> Office Action of May 6, 2004, page 8, lines 7-8.

gateway router to be a computer readable medium, nor does an internet gateway router perform the function of a computer readable medium.<sup>13</sup> The Advisory Action of August 27, 2004 did not respond to Appellant's arguments. Given the Patent Office's admission, White cannot anticipate claims 107-109. Appellant proceeds as if the Patent Office had not rejected claims 107-109 under 35 U.S.C. § 102(e), and had rejected claims 106-109 under 35 U.S.C. § 103 as being unpatentable over White. As it was the Patent Office's mutually contradictory statements which caused the confusion as to how the Patent Office was construing White, Appellant reserves the right to respond in Appellant's Reply Brief to a more fully articulated rejection of claims 106-109 under 35 U.S.C. § 102(e).

#### **D. White Does Not Render Obvious Claims 106-109, 111-114, 116, or 118-120**

##### **1. Claims 106-109 and 111-114**

Claim 106 recites a computer program product. The Patent Office admits that White does not teach this claim element.<sup>14</sup> The Patent Office proposes to modify White to include the computer program product. Specifically, the Patent Office states

one of ordinary skill in the art would have been motivated to incorporate a processor in the communication network of Fig. 12 in order to provide [sic] computer program product such as hard disk for data storage. Therefore, it would have been obvious to incorporate a processor into the communication network of Fig. 12 with the motivation being that it provides capability for the system to execute programs stored in the computer memory.<sup>15</sup>

The alleged motivation to "provide[] capability for the system to execute programs stored in the computer memory. . ." is not supported with the requisite actual evidence as required by *Kotzab*. Therefore, it is improper for the Patent Office to make this modification to White. Since White admittedly does not teach or suggest a claim element absent modification, if the Patent Office cannot modify White, then the Patent Office has not established *prima facie* obviousness. Since the Patent Office has not established *prima facie* obviousness, claim 106 and its dependent claims 107-109 and 111-114 are allowable. On this issue, claims 106-109 and 111-114 stand or fall together, but apart from the other pending claims. Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow claims 106-109 and 111-114 for this reason.

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<sup>13</sup> Response filed July 6, 2004, page 2, lines 9-26.

<sup>14</sup> Office Action of May 6, 2004, page 6, lines 5-6.

<sup>15</sup> Office Action of May 6, 2004, page 6, lines 7-13.

Appellant notes further that claims 107-109 recite a cause value. The Patent Office relies on the same assertion of inherency within White addressed above with respect to this claim element. Thus, on the issue of whether White teaches a cause value, claims 107-109 stand or fall with claim 62.

## **2. Claims 116 and 118-120**

Initially, Appellant notes that nowhere in the Office Action is claim 115 (from which claims 116 and 118-120 depend) rejected. In Appellant's previous responses, Appellant has twice raised this deficiency in the Office Action.<sup>16</sup> Since the Patent Office has never articulated the rationale under which claim 115 is rejected, the analysis of the rejections of claims 116 and 118-120 is incomplete. In essence, through Patent Office's failure to issue a complete Office Action, the Patent Office has placed Appellant in the unenviable position of having to hypothesize as to the basis of the rejection. In the interests of preserving Appellant's resources and advancing the prosecution of the present application, Appellant proceeds as if the Patent Office had rejected claim 115 under 35 U.S.C. § 103 as being unpatentable over White for essentially the same reasons that claim 106 was rejected. If the Patent Office articulates a different rationale, Appellant reserves the right to address this new rejection in the Reply Brief.

Claim 115 recites "a computer program product . . . ." The Patent Office, in its analysis of claim 106, admits that White does not show this element, and relies on a faulty motivation to modify White, as addressed above. For the reasons discussed above, this modification to White is improper, and the rejection is improper. To this extent, under Appellant's construction of the hypothetical rejection of claim 115, claims 115, 116, and 118-120 stand or fall with claim 106. Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow claims 115, 116, and 118-120.

Appellant notes further that claim 116 recites a cause value. The Patent Office relies on the same assertion of an inherent cause value within White addressed above with respect to this claim element. Thus, on the issue of whether White teaches a cause value, claim 116 stands or falls with claim 62, as explained above.

### **E. White and Creswell Do Not Render Obvious Claims 65, 67, 69, 72, 75, 80, 82, 84, 87, 95, 97, 99, 102, 105, 110, and 117 Because White and Creswell Are Not Properly Combinable**

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<sup>16</sup> Response filed February 24, 2004, page 17, lines 1-4 and Response filed July 6, 2004, page 9, lines 26-31.

Appellant initially notes that only the rejection of claims 65, 72, 80, 87, 95, 102, 110, and 117 relies on the combination of White and Creswell. The remaining claims rejected under the combination of White and Creswell (67, 69, 75, 82, 84, 97, 99, and 105) rely on White alone. To the extent that the Patent Office has rejected the claims on the combination of White and Creswell, the following argument applies, and the claims stand or fall together. More accurately, claims 67, 69, 75, 82, 84, 97, 99, and 105 stand or fall with claim 61, and claims 65, 72, 80, 87, 95, 102, 110, and 117 stand or fall together and separately from claim 61 on this issue.

The Patent Office has failed to substantiate the motivation to combine White and Creswell. The Patent Office states:

White fails to disclose an alternate language. However, Creswell discloses an alternate language (column 22, line 67-column 23, lines 1-15). One of ordinary skill in the art would have been motivated to incorporate an alternate language such as the one taught by Creswell in the communication network of White in order to improve performance. Therefore, it would have been obvious to one skilled in the art to incorporate Creswell's adjunct switch into the communication network of white with the motivation being that it provides capability for the system to operate in different languages.<sup>17</sup>

This analysis is devoid of any evidence supporting the motivations to combine the references. Absent the evidence, the motivation amounts to little more than a tautology. Since the Patent Office has not provided the actual evidence required by the Federal Circuit in *Dembiczak*, the combination is improper. Since the combination of references is improper, the rejection is improper, and the Patent Office has not established *prima facie* obviousness. Since the Patent Office has not established *prima facie* obviousness, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow claims 65, 72, 80, 87, 95, 102, 110, and 117 on this basis.

## **F. Conclusion**

The Patent Office has not shown where White teaches or suggests providing at the calling party's communication device, a packet based message providing an indication of a treatment corresponding to the attempted communication session. For this reason, all the claims are allowable. Further, the Patent Office has not shown why White should be modified, or further

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<sup>17</sup> Office Action of May 6, 2004, page 4, line 19-page 5, line 7.

why White should be combined with Creswell. For these reasons, the claims rejected under 35 U.S.C. § 103 are independently allowable. Appellant requests the Board reverse the rejections issued by the Examiner and instruct the Examiner to allow the application.

Respectfully submitted,

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## **(9) APPENDIX**

1-60. (Canceled).

61. An apparatus for receiving treatments corresponding to a calling party's unsuccessful attempt to complete a communication session, comprising:

means for attempting to initiate a communication session from a calling party's communication device to a called party's communication device across a packet based network;

means for receiving a packet based indication that the attempted communication session was not completed; and

receiving means for receiving at the calling party's communication device a packet based message providing an indication of a treatment corresponding to the attempted communication session, wherein said message is presented to the calling party through the calling party's communication device.

62. The apparatus of claim 61, wherein the receiving means includes means for receiving a cause value and an address of an associated message corresponding to the attempted communication session.

63. The apparatus of claim 62, wherein the receiving means includes means for obtaining the message from the calling party's communication device or other server.

64. The apparatus of claim 62 wherein the receiving means includes means for obtaining the message using the address.

65. The apparatus of claim 62 wherein the receiving means includes means for receiving an address for accessing the message in an alternate language.

66. The apparatus of claim 61 wherein the receiving means includes means for receiving the treatment with the message.

67. The apparatus of claim 61 wherein the receiving means includes means for receiving the treatment and for caching the treatment for later retrieval.

68. The apparatus of claim 61 wherein the receiving means includes means for receiving the indication of a particular version of the treatment.

69. The apparatus of claim 68 wherein the receiving means includes means for receiving a multimedia version of the treatment.

70. An apparatus for providing treatments corresponding to a calling party's unsuccessful attempt to complete a communication session, comprising:

means for receiving an attempt to initiate a communication session from a calling party's communication device to a called party's communication device;

means for providing a packet based indication that the attempted communication session was not completed; and

providing means for providing at the calling party's communication device a packet based message providing an indication of a treatment corresponding to the attempted communication session;

wherein said message is presented to the calling party through the calling party's communication device.

71. The apparatus of claim 70 wherein the providing means includes means for providing a cause value and an address of an associated message corresponding to the attempted communication session.

72. The apparatus of claim 71 wherein the providing means includes means for providing an address for accessing the message in an alternate language.

73. The apparatus of claim 70 wherein the providing means includes means for providing the treatment with the message.

74. The apparatus of claim 70 wherein the providing means includes means for providing the indication of a particular version of the treatment.

75. The apparatus of claim 74 wherein the providing means includes means for providing a multimedia version of the treatment.

76. A system for receiving treatments corresponding to a calling party's unsuccessful attempt to complete a communication session to a called party, comprising:

- a calling party's communication device;

- a called party's communication device including customer premises equipment for the called party;

- a network for interfacing the calling party's communication device with the called party's communication device; and

- an apparatus interfaced with the calling party's communication device, the apparatus including:

- means for attempting to initiate a communication session from the calling party's communication device to the called party's communication device;

- means for receiving a packet based indication that the attempted communication session was not completed; and

- receiving means for receiving at the calling party's communication device a packet based message providing an indication of a treatment corresponding to the attempted communication session.

77. The system of claim 76 wherein the receiving means includes means for receiving a cause value and an address of an associated message corresponding to the attempted communication session.

78. The system of claim 77 wherein the receiving means includes means for obtaining the message from the calling party's communication device or other server.

79. The system of claim 76 wherein the receiving means includes means for obtaining the message using the address.

80. The system of claim 76 wherein the receiving means includes means for receiving an address for accessing the message in an alternate language.

81. The system of claim 76 wherein the receiving means includes means for receiving the treatment with the message.

82. The system of claim 76 wherein the receiving means includes means for receiving the treatment and for caching the treatment for later retrieval.

83. The system of claim 76 wherein the receiving means includes means for receiving the indication of a particular version of the treatment.

84. The system of claim 83 wherein the receiving means includes means for receiving a multimedia version of the treatment.

85. A system for providing treatments corresponding to a calling party's unsuccessful attempt to complete a communication session, comprising:  
a calling party's communication device;  
a called party's communication device;  
a packet based network for interfacing the calling party's communication device with the called party's communication device; and  
an apparatus interfaced with the called party's communication device, the apparatus including:

means for receiving an attempt to initiate a communication session from the calling party's communication device to the called party's communication device over the packet based network;

means for providing a packet based indication that the attempted communication session was not completed; and

providing means for providing at the calling party's communication device a packet based message providing an indication of a treatment corresponding to the attempted communication session, wherein said message is presented to the calling party through the calling party's communication device.

86. The system of claim 85 wherein the providing means includes means for providing a cause value and an address of an associated message corresponding to the attempted communication session.

87. The system of claim 86 wherein the providing means includes means for providing an address for accessing the message in an alternate language.

88. The system of claim 85 wherein the providing means includes means for providing the treatment with the message.

89. The system of claim 85 wherein the providing means includes means for providing the indication of a particular version of the treatment.

90. The system of claim 89 wherein the providing means includes means for providing a multimedia version of the treatment.

91. A method for receiving treatments corresponding to a calling party's unsuccessful attempt to complete a communication session, comprising the steps of:

attempting to initiate a communication session from a calling party's communication device to a called party's communication device;

receiving a packet based indication that the attempted communication session was not completed; and

receiving at the calling party's communication device a packet based message providing an indication of a treatment corresponding to the attempted communication session.

92. The method of claim 91 wherein the second receiving step includes the step of receiving a cause value and an address of an associated message corresponding to the attempted communication session.
93. The method of claim 92 wherein the step of receiving the cause value includes the step of obtaining the message from the calling party's communication device or other server.
94. The method of claim 92 wherein the step of receiving the cause value includes the step of obtaining the message using the address.
95. The method of claim 92 wherein the step of receiving the cause value includes the step of receiving an address for accessing the message in an alternate language.
96. The method of claim 91 wherein the second receiving step includes the step of receiving the treatment with the message.
97. The method of claim 91 wherein the step of receiving at the calling party's communication device a message includes the steps of receiving the treatment and caching the treatment for later retrieval.
98. The method of claim 91 wherein the receiving step includes receiving the indication of a particular version of the treatment.
99. The method of claim 98 wherein the receiving step includes receiving a multimedia version of the treatment.
100. A method for providing treatments corresponding to a calling party's unsuccessful attempt to complete a communication session over a packet network, comprising the steps of:  
receiving an attempt to initiate a communication session from a calling party's communications device to a called party's communication device;

providing a packet based indication that the attempted communication session was not completed; and

providing at the calling party's communication device a packet based message providing an indication of a treatment corresponding to the attempted communication session, wherein said message is presented to the calling party through the calling party's communication device.

101. The method of claim 100 wherein the second providing step includes the step of providing a cause value and an address of an associated message corresponding to the attempted communication session.

102. The method of claim 100 wherein the step of providing the cause value includes the step of providing an address for accessing the message in an alternate language.

103. The method of claim 100 wherein the second providing step includes the step of providing the treatment with the message.

104. The method of claim 100 wherein the providing step includes providing the indication of a particular version of the treatment.

105. The method of claim 104 wherein the providing step includes providing a multimedia version of the treatment.

106. A computer program product, comprising:

a computer readable medium containing instructions for controlling a computer system to perform a method, the method including:

attempting to initiate a communication session from a calling party's communication device to a called party's communication device;

receiving a packet based indication that the attempted communication session was not completed; and

receiving at the calling party's communication device a packet based message providing an indication of a treatment corresponding to the attempted communication session, wherein said packet based message is presented to the calling party.

107. The computer program product of claim 106 wherein the second receiving step includes the step of receiving a cause value and an address of an associated message corresponding to the attempted communication session.

108. The computer program product of claim 107 wherein the step of receiving the cause value includes the step of obtaining the message from the calling party's communication device or other server.

109. The computer program product of claim 107 wherein the step of receiving the cause value includes the step of obtaining the message using the address.

110. The computer program product of claim 107 wherein the step of receiving the cause value includes the step of receiving an address for accessing the message in an alternate language.

111. The computer program product of claim 106 wherein the second receiving step includes the step of receiving the treatment with the message.

112. The computer program product of claim 106 wherein the step of receiving at the calling party's communication device a message includes the steps of receiving the treatment and caching the treatment for later retrieval.

113. The computer program product of claim 106 wherein the receiving step includes receiving the indication of a particular version of the treatment.

114. The computer program product of claim 113 wherein the receiving step includes receiving a multimedia version of the treatment.

115. A computer program product, comprising:  
a computer readable medium containing instructions for controlling a computer system to perform a method, the method including:  
receiving an attempt to initiate a communication session from a calling party's communication device to a called party's communication device;  
providing a packet based indication that the attempted communication session was not completed; and  
providing at the calling party's communication device, and particularly at a phone of the calling party's communication device, a packet based message providing an indication of a treatment corresponding to the attempted communication session.
116. The computer program product of claim 115 wherein the second providing step includes the step of providing a cause value and an address of an associated message corresponding to the attempted communication session.
117. The computer program product of claim 116 wherein the step of providing the cause value includes the step of providing an address for accessing the message in an alternate language.
118. The computer program product of claim 115 wherein the second providing step includes the step of providing the treatment with the message.
119. The computer program product of claim 115 wherein the providing step includes providing the indication of a particular version of the treatment.
120. The computer program product of claim 119 wherein the providing step includes providing a multimedia version of the treatment.